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REMARKS

The objection raised with respect to the Abstract of the Disclosure is overcome by the above requested Abstract amendment(s).

The objection raised with respect to the Title of the specification is overcome by the above requested Title amendment. Claim 6 is objected to for the reasons noted in the official action. The above requested amendment to claim 6 is believed to overcome all of the raised informality concerning that claim. If any further amendment to the abstract, the title or the claims is believed necessary, the Examiner is invited to contact the undersigned to discuss proposed changes to the same.

Next, claims 6, 8 and 10 are rejected, under 35 U.S.C. § 103(a), as being unpatentable over Yoon '993 in view of Townsend et al. '102; claim 7 is rejected, under 35 U.S.C. § 103(a), as being unpatentable over Yoon '993 and Townsend et al. '102, as applied to claim 6 above, and further in view of Yoon '100; and claims 9 is rejected, under 35 U.S.C. § 103(a), as being unpatentable over Yoon '993 and Townsend et al. '102, as applied to claim 6 above, and further in view of Yoon '048. The Applicant acknowledges and respectfully traverses all of the raised obviousness rejections in view of the above amendments and the following remarks.

In order to properly support an obviousness rejection under 35 U.S.C. § 103, the combined references must themselves disclose, teach, or suggest to a person of ordinary skill in the art that the references should be combined. Mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *In re Rouffet*, 149 F.3d 1350, 1355, 1357 (Fed. Cir. 1998). To the contrary, in order to properly support a combination of references, the Official Action must "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." *Id.* at 1357-59.

In the official action it is asserted that it would be obvious to a person of ordinary skill in the art to "modify the forceps mechanism of Yoon to incorporate the link mechanism, as taught by Townsend et al. . . . as the links will function to minimize stress upon the grasping

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portion, which in turn will minimize stress felt by the patient, since the grasping portion will grasp and hold a target region of the patient's body."

This assertion, though, mischaracterizes the link mechanism as taught by Townsend '102 and its desired effect on the body. The biopsy forceps disclosed in Townsend '102 are designed for cutting tissue to obtain tissue samples at a site within the body. As best seen in FIG. 11 of Townsend '102, the forceps feature a tubular control sleeve 276 that applies an axial force to the first and second links 296, 298, which in turn rotates the cutting jaws about the pivot pin 286. This allows the operator to apply *more* not less, axial force than a typical forceps mechanism, thereby resulting in additional torque to the cutting jaws to cut and retrieve a tissue sample.

Townsend in FIG. 11 discloses a 4-bar linkage which teaches a high level of torque, which is desirable for mechanisms used in biopsies and other cutting procedures. Townsend '102 explains that the linkage mechanism disclosed therein actually increases the torque at column 13, lines 13-21:

The above described embodiment provides many advantages over conventional forceps for instance the inner member 220 and the control wires 240, 241 in FIG. 7 both actuate the radial movement of the cutting jaws 120. *The additional torque provides better cutting actuation*, particularly at biopsy sites with tissue that is difficult to cut with the relatively small cutting jaws 120. (Emphasis Added)

As I recognize at page 4 of the Official Action, it is a benefit in many situations that the grasping mechanism minimizes stress on a target region of the patients body. In Yoon '993 as well as the present invention, a high level of torque is undesirable, and could damage tissue. Yoon '993 discloses a pair of grasping members 50A, 50B in FIGS. 1-5 which are normally disposed in an open position as seen in FIG. 5. As the grasping members 50A, 50B are pulled axially into the tubular outer member 36 they close together to surround a tubular part of the patients body within a space maintained between the grasping members 50A, 50B, but do not cut or clamp onto the patient's body part. In this case the amount of torque is immaterial since the grasping members need only grasp the tubular body part of the patient. Since these

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references are directed to entirely different functions, Yoon '993 to grasping a fallopian tube for tubal ligation, and Townsend et al. '102 to an increased torque for cutting tissue for biopsy procedures the Applicant believes that the disclosed mechanisms are not only entirely different but directed to different purposes and would not be combined by one of ordinary skill in the art.

Even if these references can be combined, and the Applicant does not concede such a combination in any respect, the references neither alone nor combined disclose, teach or suggest each and every feature of the presently claimed invention. Claim 6 specifically recites the features of, "a first inner tube located within the outer tube and containing a forceps mechanism and *an operating linkage constrained within the first inner tube in a closed position*". This feature of the presently claimed invention is not disclosed, taught or suggested by the cited references either alone or in combination. Support for this amendment is found in the Applicant's specification in FIG. 2A, and at page 14, para. 0038 which explains why the restraint of the link 29 within the inner tube 23 is preferable:

By restriction of the first inner tube 23, the link 29 cannot be laterally expanded. Until going outside of the first inner tube 23, the link 29 transfers expansion force thereof to the slider 27 without being expanded, and the slider 27 slides toward a direction of a[n] leading end of the forceps mechanism 3.

The inner tube 23 of the present invention provides significantly improved control of the axial extension of the forceps mechanism 3 by assisting the slider 27 and forceps to extend by the fact that the linkage 29 is constrained in the inner tube when the wire 35 is operated by a user to actuate the forceps 3. In addition, the inner tube 23 also plays a role improving the retraction control of the forceps and linkage whereby the constraint imposed by the inner tube 23 helps compress and thereby close the jaws of the forceps 3 as discussed at page 5, para. 0039,

The link 29 is pulled toward the direction of the proximate end by these forces. As the laterally expanded width of the link 29 gets hung up on an end face of the outer tube 23, the width is narrowed, and the link 29 is withdrawn inside of the first inner tube 23 . . . [t]he grasping portion 13 is closed in conjunction with this movement of the link 29.

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Again, since this feature of the presently claimed invention where the linkage is constrained within the inner tube in a closed position is not taught, disclosed or even suggested by the prior art references either alone or in combination, and in view of the above amendments and remarks the Applicant respectfully requests withdrawal of the obviousness rejection.

Also, present invention is patentable over Yoon '993 either in combination with Townsend et al. '102 or otherwise, because Yoon '993 fails to disclose, teach, or suggest the inventive step of designing a catheter for the specific purpose of insertion into blood vessels inside the heart as in the present invention, a technique that is advantageous in certain surgeries involving the myocardium. Yoon '993 claims a method of endoscopic tubal ligation comprising the steps of introducing a distal end of an instrument assembly at an internal operative site in a patient's body, visualizing the internal operative site with an endoscope, and grasping an anatomical tubular structure at the internal operative site with a grasping member of the instrument assembly disposed at the distal end.

In other words, Yoon '993 only discloses a process for performing ligation of the fallopian tubes, which involves insertion of an instrument into the peritoneal cavity; it does not teach a method for inserting any instrument into a blood vessel. By contrast, the present invention is a machine designed for insertion into blood vessels inside the heart. The Applicant has added new claims 12-18 to further clarify this aspect of the present invention.

The Applicant acknowledges that the additional references of Townsend et al. '102, Yoon '100 and/or Yoon '048 may arguably relate to the features indicated by the Examiner in the official action. Nevertheless, the Applicant respectfully submits that the combination of the base reference of Yoon '993 with this additional art of Townsend et al. '102, Yoon '100 and/or Yoon '048 still fails to in any way teach, suggest or disclose the above distinguishing features of the presently claimed invention. As such, all of the raised rejections should be withdrawn at this time in view of the above amendments and remarks.

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If any further amendment to this application is believed necessary to advance prosecution and place this case in allowable form, the Examiner is courteously solicited to contact the undersigned representative of the Applicant to discuss the same.

In view of the above amendments and remarks, it is respectfully submitted that all of the raised obviousness rejections should be withdrawn at this time. If the Examiner disagrees with the Applicant's view concerning the withdrawal of the outstanding rejection(s) or applicability of the Yoon '993, Townsend et al. '102, Yoon '100 and/or Yoon '048 references, the Applicant respectfully requests the Examiner to indicate the specific passage or passages, or the drawing or drawings, which contain the necessary teaching, suggestion and/or disclosure required by case law. As such teaching, suggestion and/or disclosure is not present in the applied references, the raised rejection should be withdrawn at this time. Alternatively, if the Examiner is relying on his/her expertise in this field, the Applicant respectfully requests the Examiner to enter an affidavit substantiating the Examiner's position so that suitable contradictory evidence can be entered in this case by the Applicant.

In view of the foregoing, it is respectfully submitted that the raised obviousness rejection(s) should be withdrawn and this application is now placed in a condition for allowance. Action to that end, in the form of an early Notice of Allowance, is courteously solicited by the Applicant at this time.

The Applicant respectfully requests that any outstanding objection(s) or requirement(s), as to the form of this application, be held in abeyance until allowable subject matter is indicated for this case.

In the event that there are any fee deficiencies or additional fees are payable, please charge the same or credit any overpayment to our Deposit Account (Account No. 04-0213).

Respectfully submitted,



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